

REMARKS

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This Amendment is filed in response to the Office Action dated October 5, 2006.

Rejection Under 35 U.S.C. §112

Claim 29 was rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter that the Applicant regards as the invention. Claim 29 was cancelled and this rejection is thereby respectfully believed to be rendered moot.

Rejection Under 35 U.S.C. §102(e)

Claim 1 and Claim 21 are rejected under 35 U.S.C. §102(e) as being anticipated by Mankins et al. (U.S. Patent No. 6,850,209). Claim 1 (apparatus claim) and Claim 21 (associated method claim) have been amended to recite: "...the support frame being operatively connected to a single mount, wherein the single mount is adapted and configured to operatively connect the polygonal display to a center pole ... wherein the polygonal display is located within a retail outlet in an elevated position;...". Applicant's Published Patent Application (U.S. Patent Application No. 2004/0103570) recites: "There is a center pole 80 that is secured to the aforementioned support frame 42". (Page 5, Paragraph [0059], Lines 1-2). Applicant's Published Patent Application (U.S. Patent Application No. 2004/0103570) also recites: "**A mount** 149 is secured to the inturned flange 146 and has a threaded hole 150 for mounting of the display 101 on a pole 80:.. (Page 7, Paragraph [0076], Lines 1-3). Also, Claims 3 and 22 are

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canceled with the limitations incorporated into Claims 1 and 21, respectively. Therefore, no new matter has been added.

Mankins et al., in marked contrast, is a movable advertising display attached to a vehicle and is not an advertising display mounted to a center pole within a retail establishment. The mount (1048 in FIGS. 67-68) is not a single mount but one of a pair of mounts attached to the top of a roof of a moving vehicle. The advertising display is not positioned on a center pole within a retail establishment. In marked contrast, Mankins et al. recites: "The location profile control 616 allows the user to define location criteria in multiple different ways. As indicated in 620, a user can define location criteria by various types of locations including: residential areas; entertainment venues; educational venues, such as universities; parks; government buildings; selected tunnels and bridges; business districts; tourist areas; art galleries; restaurants; movie theaters; 24-hour stores; toll booths; high traffic areas; airports; taxi stands; subway stops; various specified types of stores; various named businesses; and any other location types which have been made selectable by the interface. The user can also select locations by other methods, such as by the town or city they occur in, by geon's having locations corresponding to a **predefined geosynchron set**, or by a predefined set of geon's. Other methods of specifying geosynchrons can include by nearness to a given location or class of locations, such as **nearness to schools, or nearness to airports, or nearness to stores** bellowing to a given merchant". (Column 36, Lines 9-27). These are all locations where the vehicle, i.e., cab, will either pass by or stop near. The technology is for changing the advertising display depending on where the vehicle, e.g., cab, is located. Mankins et al. never contemplates that the vehicle, i.e., cab, will be located inside or within a retail establishment.

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Under 35 U.S.C. §102, “the identical invention must be shown in as complete detail as is contained in the ... claim”. Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989). “A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference”. Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). Moreover, when evaluating a claim for either anticipation or obviousness, all claim limitations must be considered. In re Evanega, 829 F.2d 1110, 4 U.S.P.Q. 2d 1249 (Fed. Cir. 1987).

Moreover, proper application of a reference against a device described and claimed in a patent application requires broadly that the anticipatory device be substantially the same as the anticipated device in function, structure and result. In this case, the structure is very different with Mankins et al. providing a structure mounted on top of a moving vehicle, e.g., cab. There is no center pole with multiple mounts 1408.

It is now a basic tenet of patent law that the United States Patent Office is not permitted to ignore the results and advantages of the claimed subject matter, of which the prior art is devoid, simply because the claim limitations are similar to the otherwise barren prior art.

In addition, hindsight is not the test of anticipation nor is it alone sufficient that other disclosed devices might have been adapted without too much difficulty to produce the object and function of the Applicant’s Invention. **There is absolutely no motivation to modify Mankins et al. since there is no center pole and a single mount would destroy the function of Mankins et al. since the advertising display must be secured at all corners to make sure the advertising display does not leave the top of the vehicle in high winds and other**

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environmental factors in addition to the force created by the motion of the vehicle to dislodge the advertising display from the roof of the vehicle.

Therefore, it is respectfully believed that Claims 1 and 21 overcome the rejection under 35 U.S.C. § 102(e) and are patentable over Mankins et al. and are in condition for allowance.

Claims 2-3, 7-10, 13-16, 22 and 24-25 are also rejected under 35 U.S.C. § 102(e) over Mankins et al. Claims 2-3, 7-10, 13-16, 22 and 24-25 depend from Claim 1 and Claim 21, respectively. If an independent claim is not anticipated under 35 U.S.C. § 102, then any claim depending therefrom is also not anticipated. In re Fine, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). Moreover, Claims 3 and 22 are canceled and it is respectfully believed that this rejection with regard to these two claims is rendered moot. Therefore, Claims 1-2, 7-10, 13-16, 21 and 24-25 overcome the rejection under 35 U.S.C. § 102(e) and are in condition for allowance.

Rejection Under 35 U.S.C. §103(a)

Claims 4-5 and 23 are rejected under 35 U.S.C. §103(a) as being unpatentable over Mankins et al. (U.S. Patent No. 6,850,209) in view of Kim (U.S. Patent Application No. 2004/0046704). Claims 4-5 and 23 are cancelled and this rejection is thereby respectfully believed to be rendered moot.

Claims 11-12 and 29 are rejected under 35 U.S.C. §103(a) as being unpatentable over Moscovitch et al. (U.S. Patent No. 6,343,006) in view of Mankins et al. (U.S. Patent No. 6,850,209). Claims 11-12 and 29 are canceled and this rejection is thereby respectfully believed to be rendered moot.

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Claims 17-18, 20 and 26 are rejected under 35 U.S.C. §103(a) as being unpatentable over Mankins et al. (U.S. Patent No. 6,850,209) in view of Goldman (U.S. Patent No. 4,679,341).

Claims 17-18, 20 and 26 all depend from Claim 1 and have all of the limitations thereof. Claims 17-18, 20 and 26 are patentable over Mankins et al. in the same manner as Claim 1 above since if an independent claim is nonobvious under 35 U.S.C. §103, then any claim depending therefrom is nonobvious. In re Fine, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). Moreover, a specific requirement of Goldman is that: “The present invention comprises a modular display apparatus for slidably receiving, maintaining and displaying one or more flat multi-sided signage panels in a **desired orientation**.” (Column 1, Lines 63-66). This is a marked contrast to the Applicant’s invention that specifically requires: “...wherein the at least one first display panel, the at least one second display panel and the at least one third display panel are facing **generally in different directions**;...”. Therefore, the prior art teaches away by stipulating that there must be a single **desired orientation** rather than different directions. The Supreme Court held in U.S. v. Adams, 383 U.S. 39, 148 U.S.P.Q. 479 (1966), that one important indicium of nonobviousness is “teaching away” from the claimed invention by the prior art or by experts in the art at (and/or after) the time the invention was made. This is specifically mandated by the Manual of Patent Examining Procedure (M.P.E.P.) §2141.02 that recites: “A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention”. W.L. Gore & Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 220 U.S.P.Q. 303 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984).”

It is well established in U.S. Patent Law as well as the Manual for Patent Examining Procedure (M.P.E.P.) §2143.03 that “to establish *prima facie* obviousness of a claimed invention,

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all the claim limitations must be taught or suggested by the prior art”. In re Royka, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974). “All words in a claim must be considered in judging the patentability of that claim against the prior art.” In re Wilson, 424 F.2d 1382, 1385, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970). In this case, the limitation regarding the three displays panels facing three different directions is not found in Goldman, which requires the rectangular display panel face in a single, desired direction. When evaluating a claim for obviousness, all claim limitations must be considered. In re Evanega, 829 F.2d 1110, 4 U.S.P.Q. 2d 1249 (Fed. Cir. 1987).

Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. “The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art.” In re Kotzab, 217 F.3d 1365, 1370, 55 U.S.P.Q.2d 1313, 1317 (Fed. Cir. 2000). See also In re Lee, 277 F.3d 1338, 1342-44, 61 U.S.P.Q.2d 1430, 1433-34 (Fed. Cir. 2002) (discussing the importance of relying on objective evidence and making specific factual findings with respect to the motivation to modify or combine references); In re Fine, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988); In re Jones, 958 F.2d 347, 21 U.S.P.Q.2d 1941 (Fed. Cir. 1992).

Moreover, “if proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the

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proposed modification”. In re Gordon, 733 F.2d 900, 221 U.S.P.Q. 1125 (Fed. Cir. 1984). In this case a reference, i.e., Goldman, requires the advertising display face a single “desired direction”. This will create a tremendous problem and destroy the recited purpose of the advertising display if it is simultaneously facing and viewed from three different directions. “In determining the propriety of the Patent Office case for obviousness in the first instance, it is necessary to ascertain whether or not the reference teachings would appear to be sufficient for one of ordinary skill in the relevant art having the reference before him to make the proposed substitution, combination, or other modification”. In re Linter, 458 F.2d 1013, 1016, 173 U.S.P.Q. 560, 562 (C.C.P.A. 1972).

Therefore, Claims 17-18, 20 and 26 are respectfully believed to overcome the rejection under 35 U.S.C. §103(a) as being unpatentable over Mankins et al. in view of Goldman.

Claim 19 was rejected under 35 U.S.C. §103(a) as being unpatentable over Mankins et al. (U.S. Patent No. 6,850,209) in view of Goldman (U.S. Patent No. 4,679,341) and further in view of Gebka (U.S. Patent No. 5,458,307). Claim 19 depends from Claim 18 and overcomes the rejection under 35 U.S.C. §103(a) in the same manner as Claim 18 recited above. Moreover, Claim 19 depends from independent Claim 1. If an independent claim is nonobvious under 35 U.S.C. §103, then any claim depending therefrom is nonobvious. In re Fine, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). Moreover, Gebka recites: “Since plastic price channels are generally made as extrusions of somewhat **hard polyvinyl chloride (PVC)** having a low friction or glossy outer surface, a problem which may arise in use, is that inserted labels can slide and become easily displaced along the channel to positions in which they may no longer be properly positioned relative to the products with which they are intended to be associated. The present

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invention **overcomes this problem**, at least to a substantial extent". (Column 1, Lines 19-27).

Therefore, although rigid PVC material is disclosed Gebka teaches away from a hard PVC by the use of: "It is an object of the invention to provide an improved plastic price channel of the kind referred to which reduces the ability for attached labels to slide along the channel. ... The rib coating may be co-extruded from a **"flexible" PVC** such as Teknor Apex Company's 3165 Compound or Synergistics' Clear Compound 0750. Of course, these commercially available PVC extrusion compounds are identified as illustrative" (Column 1, Lines 32-57). Therefore, the invention in Gebka is to use a flexible PVC in a plastic price label to reduce friction when moved along the channel. Someone with ordinary skill in the art would be taught away from utilizing rigid PVC upon review of this reference for both the exterior shell and backing member. The Supreme Court held in U.S. v. Adams, 383 U.S. 39, 148 U.S.P.Q. 479 (1966), that one important indicium of nonobviousness is "teaching away" from the claimed invention by the prior art or by experts in the art at (and/or after) the time the invention was made. This is specifically mandated by the Manual of Patent Examining Procedure (M.P.E.P.) §2141.02 that recites: "A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention". W.L. Gore & Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 220 U.S.P.Q. 303 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984)."

Therefore, Claim 19 is respectfully believed to overcome the rejection under 35 U.S.C. §103(a) as being unpatentable over Mankins et al. in view of Goldman and further in view of Gebka.

Claims 27-28 were rejected under 35 U.S.C. §103(a) as being unpatentable over Mankins et al. (U.S. Patent No. 6,850,209) in view of Pogue (U.S. Patent No. 3,167,874). Claim 27 is

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now canceled and it is respectfully believed that this rejection with respect to this Claim is rendered moot. Claim 28 is now amended to depend from Claim 1 and overcomes the rejection under 35 U.S.C. §103(a) in the same manner as Claim 1 recited above. If an independent claim is nonobvious under 35 U.S.C. §103, then any claim depending therefrom is nonobvious. In re Fine, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). Moreover, Pogue shows in Fig. 4, that there are several mounts to attach the advertising display to the pole and not a single mount. It is well established in U.S. Patent Law as well as the Manual for Patent Examining Procedure (M.P.E.P.) Section 2143.03 that “to establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art”. In re Royka, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974). “All words in a claim must be considered in judging the patentability of that claim against the prior art”. In re Wilson, 424 F.2d 1382, 1385, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970). Consequently, it is respectfully believed to be axiomatic that a feature, i.e., single mount, not disclosed in either Mankins et al. or Pogue cannot come into being by their combination.

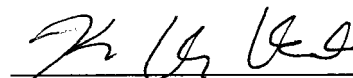
Therefore, Claim 28 is respectfully believed to overcome the rejection under 35 U.S.C. §103(a) as being unpatentable over Mankins et al. in view of Pogue.

CONCLUSION

Therefore, it is now believed that all of the pending Claims in the present application are in condition for allowance. Favorable action and allowance of the Claims is therefore respectfully requested. If any issue regarding allowability of any of the pending Claims in the present application could be readily resolved, or if other action could be taken to further advance this application such as an Examiner's Amendment, or if the Examiner should have any questions regarding the present Amendment, it is respectfully requested that the Examiner please telephone the Applicant's undersigned attorney in this regard.

Respectfully submitted,

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